APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,551	07/06/2001	Alicia Anne Chastain	RSW920010058US1	5014

36736	7590	03/11/2004

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EXAMINER
LY, ANH

ART UNIT	PAPER NUMBER
2172	

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/900,551	CHASTAIN ET AL.
	Examiner	Art Unit
	Anh Ly	2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *13 February 2004*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-27* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicants' arguments filed 02/13/2004 have been fully considered but they are

not persuasive.

Applicants' argued that, "Nochur and Hager do not teach selecting text from an

electronic book and automatically sending the selected text to each electronic book for a

designated set of recipients." (Page 10, lines 12-14; Page 12, lines 27-30and Page 16,

lines 13-15).

Nochur et al. (hereinafter Nochur) of 5,835,758 teaches selecting the text or

document and then selecting the relevant element of the text (col. 7, lines 42-65 and

col. 8, lines 35-38). Also, Hager et al. (hereinafter Hager) of 5,247,661 teaches

automatically sending or transmitting the electronic document to a designated set of

recipients from a list of recipients (see abstract, col. 2, lines 25-38 and col. 4, lines 25-

37).

Applicants' argued that, "these two references are directed towards different

problem and solutions when they are considered as a whole by one of ordinary skill in

the art. ... for combining these references" (Page 15, lines 34-37).

Nochur teaches electronic documents or emails or memos or text documents can

be sent or transferred over a network (col. 7, lines 54-65and col. 9, lines 61-67 and col.

10, lines 1-10), whereas Hager teaches distributing electronic documents (see abstract).

Thus, both of them have the same distributing or transferring electronic document over

a network environment.

Applicants' argued that, "The cited sections do not teach that the sorted text

excludes a portion of the selected text." (Page 21, lines 13-14).

Nochur teaches selecting and sorting the text documents for the customizable

reports for the users who specify the formats for the various reports that base don the

attributes of the items (col. 5, lines 20-65).

1.   Claims 1-27 are pending in this application.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

4.   Claims 1-2, 9-12, 23 and 26-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent No. 5,835,758 issued to Nochur et al. (hereinafter Nochur

in view of US Patent No. 5,247,661 issued to Hager et al. (hereinafter Hager).

With respect to claim 1, Nochur discloses receiving a user input selecting the text

from the electronic book to form selected text (the user enters the text document and

selects the desired text to be transferred: col. 7, lines 42-65 and col. 11, lines 42-53).

Nochur discloses a distributed computer system comprising a plurality of

computer-based documents, which can be shared among various users on the network.

The text document or selected text can be sent or forwarded to other users or recipients

who are listed from a list of people available in database and are selected by the sender

(col. 9, lines 65-67 and col. 10, lines 1-10). Nochur does not explicitly teach

automatically sending the selected text to each electronic book for a designated set of

recipients in response to receiving the user input selecting the text.

However, Hager discloses the selected text or document is automatically

transmitted to a designated set of recipients from the list of recipients (col. 2, lines 25-38

and col. 4, lines 25-37; also see abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to combine the teachings of Nochur with the teachings

of Hager so as to obtain a method for distributed the selected text document with a

desired recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager – abstract) over a computer network within data processing system.

With respect to claim 2, Nochur discloses displaying a list wherein the designated set of recipients is selected from the list (col. 9, lines 61-67 and col. 10, lines 1-10).

With respect to claims 9-12, Nochur discloses wherein the sending step sends the highlighted text to the designated set of recipients using a communications link; wherein the sending step sends the highlighted text to the designated set of recipients in an electronic mail message; wherein the highlighted text is located in a body of the electronic mail message and wherein the highlighted text is located in an attachment attached to the electronic the electronic mail message (see abstract, communications link over the network: col. 5, lines 28-54 and computer message sending over the network is a electronic mail message: col. 7, lines 10-67).

Claim 23 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 26 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 27 is essentially the same as claim 1 except that it is directed to a

computer program product in a computer readable medium rather than a method, and is

rejected

5.   Claims 3-8, 13-14, 16-22, 24-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent No. 5,835,758 issued to Nochur et al. (hereinafter Nochur

in view of US Patent No. 5,247,661 issued to Hager et al. (hereinafter Hager) and

further in view of Patent No. 5,893,132 issued to Huffman et al. (hereinafter Huffman).

With respect to claims 3-8, Nochur in view of Hager discloses a method in a data

processing as discussed in claim 1.

Nochur discloses a distributed computer system comprising a plurality of

computer-based documents, which can be shared among various users on the network.

The text document or selected text can be sent or forwarded to other users or recipients

who are listed from a list of people available in database and are selected by the sender

(col. 9, lines 65-67 and col. 10, lines 1-10). Nochur does not explicitly teach

automatically sending the selected text to a designated set of recipients in response to

receiving the user input selecting the text. Hager teaches automatically sending the

selected to a designated set of recipients. In combination, Nochur and Hager do not

teach highlight text, text in a different color from unselected text, data structure,

download file, text in electronic book.

However, Huffman discloses wherein the selected text is highlighted text. (col. 19, lines 1-20 and col. 23, lines 25-36); wherein the highlighted text is text in a different color from unselected text, bolded text, and text with a different font type from unselected text (col. 23, lines 25-36); storing the highlighted text in a data structure (web page having HTML or hyperlinks or hypertext: col. 19, lines 1-20; also see col. 16, lines 5-14); wherein data structure is a download file (download the text files: col. 12, lines 55-67); wherein the text is a notated passage of text in the electronic book (col. 2, lines 32-42); wherein the text is a highlighted passage of text in the electronic book (col. 19, lines 1-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nochur in view of Hager with the teachings of Huffman so as to obtain a hand-held electronic reading devices incorporating with user interface, which allows a user to navigate through the textual information and access various features of electronic reading device (col. 2, lines 24-42 and col. 16, lines 5-14); highlight feature in the electronic book and performing different fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col. 23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and sending or transmitting the text to the user (col. 6, lines 26-36). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager – abstract) and a method for distributed the selected text document with a desired

recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10)

over a computer network within data processing system.

With respect to claim 13, Nochur discloses receiving a first user input selecting

the text from the electronic book to form selected text (the user enters the text

document and selects the desired text to be transferred: col. 7, lines 42-65 and col. 11,

lines 42-53), displaying a list of recipients (col. 9, lines 61-67).

Nochur discloses a distributed computer system comprising a plurality of

computer-based documents, which can be shared among various users on the network.

The text document or selected text can be sent or forwarded to other users or recipients

who are listed from a list of people available in database and are selected by the sender

(col. 9, lines 65-67 and col. 10, lines 1-10). Nochur does not explicitly teach

automatically sending the selected text to a designated set of recipients in response to

receiving the user input selecting the text. Hager teaches the selected text or document

is automatically transmitted to the preselected recipients (col. 2, lines 25-38 and col. 4,

lines 25-37). In combination, Nochur and Hager do not explicitly indicate receiving a

second user input.

However Huffman discloses receiving a second user input (col. 17, lines 45-58).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to combine the teachings of Nochur in view of Hager

with the teachings of Huffman so as to obtain a hand-held electronic reading devices

incorporating with user interface, which allows a user to navigate through the textual

information and access various features of electronic reading device (col. 2, lines 24-42

and col. 16, lines 5-14); highlight feature in the electronic book and performing different

fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col.

23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and

sending or transmitting the text to the user (col. 6, lines 26-36). This combination would

have made a method in a data processing system being able to create or select a text

document in order for automatically sending or forwarding to the receiver(s) (Hager –

abstract) and a method for distributed the selected text document with a desired

recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10)

over a computer network within data processing system.

With respect to claim 14, Nochur discloses receiving selected text from at least

one electronic book through a communications link to the data processing system (see

abstract and col. 7, lines 10-67), and displaying the text or selected text (col. 8, lines 12-

24 and col. 9, lines 1-12).

Nochur discloses a distributed computer system comprising a plurality of

computer-based documents, which can be shared among various users on the network.

The text document or selected text can be sent or forwarded to other users or recipients

who are listed from a list of people available in database and are selected by the sender

(col. 9, lines 65-67 and col. 10, lines 1-10) and sorting the data from the at least one

remote electronic book and displaying the data. Nochur does not explicitly teach sorting

the selected text using selection criteria to form sorted text. Hager teaches sorting the

text based on criteria such as functional area field of a file (col. 7, lines 55-65). In

combination, Nochur and Hager do not teach highlighting the portion of the electronic book based n the user input.

However, Huffman discloses wherein the selected text is highlighted text. (col. 19, lines 1-20 and col. 23, lines 25-36; web page having HTML or hyperlinks or hypertext: col. 19, lines 1-20; also see col. 16, lines 5-14 and col. 19, lines 1-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nochur in view of Hager with the teachings of Huffman so as to obtain a hand-held electronic reading devices incorporating with user interface, which allows a user to navigate through the textual information and access various features of electronic reading device (col. 2, lines 24-42 and col. 16, lines 5-14); highlight feature in the electronic book and performing different fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col. 23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and sending or transmitting the text to the user (col. 6, lines 26-36). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager – abstract) and a method for distributed the selected text document with a desired recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10) over a computer network within data processing system.

With respect to claims 16-17 and 20-22, Nochur discloses the sorted text and displaying the sorted text (sorting the data: col. 5, lines 60-65; displaying the data: col. 8, lines 12-24 and col. 9, lines 1-12).

With respect to claims 18-19, Nochur in view of Hager discloses a method as discussed in claim 14.

In combination, Nochur and Hager do not discloses electronic book including selected text with annotations made by a user.

However, Huffman discloses wherein the selected text includes passages from at least one electronic book; and wherein the selected text includes annotations made by a user (col. col. 6, lines 25-36col. 7, lines 30-46 and col. 16, lines 4-12).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nochur in view of Hager with the teachings of Huffman so as to obtain a hand-held electronic reading devices incorporating with user interface, which allows a user to navigate through the textual information and access various features of electronic reading device (col. 2, lines 24-42 and col. 16, lines 5-14); highlight feature in the electronic book and performing different fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col. 23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and sending or transmitting the text to the user (col. 6, lines 26-36). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager – abstract) and a method for distributed the selected text document with a desired recipient from a list of recipients stored in the database (Nochur - col. 10, lines 1-10) over a computer network within data processing system.

Claim 24 is essentially the same as claim 13 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 13 hereinabove.

Claim 25 is essentially the same as claim 14 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 14 hereinabove.

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is 703 306-4527 or via E-Mail: ANH.LY@USPTO.GOV. The examiner can normally be reached on 7:30 AM - 4:00 PM.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

-or faxed to: Central Office (703) 872-9306 (effective from 08/04/2003)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-6606 or 703 305-3900.

JEAN M. CORRIELUS
PRIMARY EXAMINER

AL
MAR. 9th, 2004